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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,803	01/14/2004	James McSwiggen	SIR-MIS-00001-US-CIP[4]	5421
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Merck c/o Sima Therapeutics, Inc. 1700 Owens Street 4th Floor San Francisco, CA 94158			EXAMINER BOWMAN, AMY HUDSON	
			ART UNIT	PAPER NUMBER
			1635	
			NOTIFICATION DATE	DELIVERY MODE
			12/30/2010 ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<p style="text-align: center;"><i>Advisory Action</i> <i>Before the Filing of an Appeal Brief</i></p>	<p>Application No. 10/757,803</p>	<p>Applicant(s) MCSWIGGEN ET AL.</p>	
	<p>Examiner AMY BOWMAN</p>	<p>Art Unit 1635</p>	

--THE MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 December 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____
- Claim(s) objected to: _____
- Claim(s) rejected: 18-20 and 33-49
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Applicant argues the rejection under 35 USC 103(a) and argues that Elbashir et al. teaches away from modifying beyond the 3' nucleotides. Applicant continues to argue the interpretation of the Elbashir et al. reference. However, the instant claims require a total of 10 pyrimidines between the sense and antisense strand to be modified (diminimus of the claim), which is an extension of one nucleotide on each 3' end being modified when compared to Elbashir et al., wherein the board agreed that Elbashir et al. is silent as to data between 19% modification of the duplex and 100% modification of one or both strands.

It is noted that the interpretation of the Elbashir et al. (Tuschl) reference is argued in detail by applicant. However, the interpretation of the article has already been decided by the Board in the related appeal (Reexamination control 90/008,177, Patent 7,022,858), and the interpretation is consistent with that of the examiner in the instant rejection.

On page 27 of the decision, the board sets forth that appellant's argument that Tuschl teaches avoiding any 2'-O-methyl modifications is unpersuasive and misstates the teachings of Tuschl. A fair reading is that more extensive 2'-deoxy or 2'-O-methyl modification beyond the two nucleotide 3'-overhang reduces the ability of siRNAs to mediate RNAi. Stating that complete substitution abolished RNAi is not the same of stating that any 2'-O-methyl modification should be avoided. It is noted that when incorporating chemical modifications into nucleic acid inhibitory molecules, it is routine to balance stability and activity. Therefore, it is a matter of routine optimization to determine an acceptable balance between a reduction in activity and an increase in stability, as long as the molecule is still in fact active.

The decision also sets forth that nucleic acid molecules are known to be degraded or hydrolyzed by nucleases in vivo and in culture systems and thus it is routine in the art to modify nucleic acids to resist nuclease hydrolysis, and particularly to modify with modifications that were known to enhance stability. Similarly, capping as disclosed by Matulis-Adamic et al. would be reasonably expected to sterically interfere with the active site of a nuclease (see page 25 of decision, for example).

Applicant argues that there would not have been a reasonable expectation of success. Contrary to applicant's argument, this is not

/AMY BOWMAN/
Primary Examiner, Art Unit 1635